

### **Remarks**

This amendment is responsive to the official action mailed November 16, 2005, and is accompanied by a Petition for Extension under 37 C.F.R. §1.136(a). Also submitted is a supplemental information disclosure statement form PTO/SB/8A.

Item 2 of the Office Action requires an affirmation of the provisional election of November 4, 2005 to prosecute the invention of species 3 as evidenced by Figures 6-8 and claims 1-4, 10 and 12-15. Applicant affirms the provisional election. The nonelected claims, were withdrawn from consideration by the examiner, and now have been either amended to direct the claims to the elected embodiment or canceled.

Three new claims are added, directed to the elected embodiment. No new matter is presented. The claims remain within the number for which filing fees have been paid.

In Item 3 of the Office Action, the examiner takes the position that the information disclosure statement filed September 2, 2003 is not in compliance with 37 C.F.R. 1.98(a)(3) because it lacked a concise explanation of relevance of references that were not in the English language. Applicant re-submits a form PTO/SB/8 listing the three DE references that were not considered, and the fee for a late information disclosure statement. Copies of the references have already been submitted into the IFW system. Applicant requests that the references be considered and cited of record.

The references are considered relevant because they were cited in a search report in a corresponding German patent application and disclose flange arrangements. A copy of the search report has already been submitted. A concise explanation of the references is as follows:

#### **DE 3237419:**

The reference refers to a housing of a normal mixing valve. This housing is partly inserted into a wall 5. This housing has a preferably single piece circumferential

flange 7. A foil 9 is clamped between the flange 7 and an annular counter flange 8. This is achieved by several screws 8 which press the counter flange 8 against the circumferential flange 7.

**DE 3237418:**

This box has two parts. One part 1 has an outer flange 5 which is formed in one piece with the box. The second part 3 has also an outer flange which is formed in one piece with the second or outer part 3. The flanges are screwed together (*e.g.*, see Fig. 2 at the numeral 7). After the completion of this installation the outer part 3 is tethered with a tool. Such prior art is mentioned in the second paragraph of page 1 of the specification.

**DE 3310138:**

This box has several rings at its outer side (*e.g.*, see Fig. 2). During installation, a special member as shown in Fig. 1 can be inserted between two rings so that the distance between the element 1 and the front edge of this box can be adapted. This box is not intended or able to hold a mixing valve or such a like.

Applicant's claimed invention is believed patentable over the foregoing prior art, considered alone or in combinations including the prior art already of record. Nevertheless, applicant requests that the references be considered for the foregoing aspects and cited of record.

In Item 4 of the Office Action, the examiner objects to the drawings under 37 C.F.R. §1.83(a), because they do not show the rear and front surface of a dry wall panel as recited in claims 13 and 14 respectively. Claims 13 and 14 have been canceled, without prejudice, thereby obviating the rejection. The invention as now claimed is defined with respect to the structures of the installation device as opposed to the environment where it may advantageously be installed.

In Items 5-12 of the Office Action, claims 1-4, 10 and 12-15 are rejected under 35 U.S.C. §102(b) as anticipated by Huff (U.S. Patent No. 2,143,517). Reconsideration is requested in view of this amendment.

The apparatus described in Huff is an outlet box, not an installation device for plumbing elements as in the instant claims. There is no teaching or suggestion that one might attempt to mount plumbing fixtures (water carrying fixtures, valves and the like) in an installation configured for electric devices.

Moreover, the flange (6) described in Huff resides at a fixed and predetermined distance from the front edge of the tray (see Fig. 3). Huff's flange can only be mounted using bayonet slots (3), which have a fixed depth. There is no disclosure or suggestion or how or why Huff might be arranged or modified to provide structures at a plurality of distances from the front edge, at which the flange might be affixed. Huff's flange can be turned over, which affects its position, but Huff does not provide or suggest the possibility of attachment structures placed at different distances from the edge, and has only one level for attachment. Huff does not meet the invention as claimed and does not render the claimed invention obvious.

Applicant's claim 1 has been amended to recite that the flange is attached to the box at a selectably variable distance back from the edge. In the elected embodiment shown in Figs. 6-8, there are six grooves at different distances from the edge 4, where the flange 8 can be fixed. The flange 8 has inward protrusions 23 that fit into grooves 21. The flange 8 is placed over the box and moved to one of the grooves 21 for selectably varying the distance back from the edge. When placed, the flange 8 is rotated, thereby engaging protrusions 23 in the selected groove 21. There is no comparable teaching in the cited prior art.

The cited reference lacks the claimed structure and fails to anticipate the subject claimed as a whole. The reference lacks any structure similar the claimed structure that meets or suggests the same function and does not render the claimed invention

obvious. Therefore, claim 1 and the claims depending from claim 1 are patentable over Huff. There is no teaching or suggestion that a flange as claimed could or should be fastened around a box at a selectably variable distance from the open front edge.

In Items 13-15 of the Office Action, claims 1, 3, 4, 12 and 15 were rejected under 35 U.S.C. §102(b) as anticipated by Kifer (U.S. Patent No. 4,410,004). Reconsideration is again requested. Kifer does not meet or suggest the subject matter claimed as a whole.

Kifer has a cover flange part 18 that provides a structure around the open edge of the box. That flange part 18 is simply pushed down over the box. Flange 18 is not involved in positioning the box.

Kifer has four mounting tabs 16 that are serve to mount the box between spaced studs 12. These tabs 16 are independent and do not resemble a flange as disclosed by applicant, but when adjusted independently would permit the box to be positioned inwardly or outwardly relative to the wall. Kifer's adjustable mounting relative to the wall studs is not the same as applicants selectably variable position of a flange, because applicant's device can be selectably set to a desired distance between the flange and the edge of the box (to correspond to the thickness of the drywall or other wall surface covering), whereas Kifer's arrangement is positioned on the studs by independent adjustments.

As described in Kifer at col. 6, lines 7 to 17, the legs 102 are each inserted into a corresponding mounting loop 92, opening toward the front and formed by the side wall 24, an outer loop wall 104 and top and bottom end walls 106 and 108. The legs 102 of Kifer's mounting tabs 16 are movable relative to the box. As described at col. 6, lines 18-45, it is possible to set the mounting tabs at different depths, and two such depths are shown in Figs. 6A, 6B. However the cooperating structures that provide for multiple mounting depths are the loop 92 on the box. There is only a single loop position at one and only one space from the front edge of the box. Thus Kifer does not anticipate the invention as defined in the claims as amended.

Accordingly the cited references each fail to disclose the invention claimed as a whole. Furthermore, there is no routine possibility by which aspects of the references might be combined to result in the claimed invention. The flange of Huff, for example, has a skirt part that extends around the circumference and would preclude insertion into a loop or other fixture having a small dimension.

It is possible in Huff to place the flange in either of two opposite orientations, but there is only one corresponding mounting structure on the surface of the box. Likewise in Kifer, it is possible to make various independent adjustments to float the front edge of the box up to the plane of the wall surface. Nevertheless, there is just one level at which the mounting loops are provided. In each case the prior art takes a fundamentally different approach compared to applicant's installation device as disclosed and claimed.

Applicant's claims have been amended to particularly define the aspects wherein the invention differs from the prior art. Among other changes, claims are presented that are more nearly directed to the preferred embodiments shown in Figs. 6-8. There is nothing in the prior art that reasonably compares to applicant's arrangement wherein plural grooves are spaced back from the edge of the box and provided on tangential portions between which the grooves can be entered by the inward protrusions of the flange.

There is no disclosure in the prior art of the idea of providing an array of mounting ribs or grooves as in applicant's invention. If the person of ordinary skill somehow considered plural depth positions as a possibility, it would be necessary to invent some way to provide engagement structures that can be passed over by the flange in moving to lower levels, such as applicant's inward protrusions 23, received in grooves 21, which are placed at the relatively bulged tangential surfaces providing an entry into the grooves. The prior art fails to disclose the structure as claimed and fails to suggest a similar approach to the problem of placing a flange at different depths relative to a front edge of a box.

The claims have been amended for definiteness and to better distinguish over the prior art of record. The differences between the invention and the prior art are such

that the subject matter claimed, as a whole, is not shown to have been known or obvious. Therefore, the application is in condition for allowance. Reconsideration and allowance are requested.

Respectfully submitted,

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